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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,927	07/27/2001	Ruben G. Duran	Duran-1	8764
30438 7590 03/25/2010 SMYRSKI LAW GROUP, A PROFESSIONAL CORPORATION 3310 AIRPORT AVENUE, SW SANTA MONICA, CA 90405				
EXAMINER				
DASS, HARISH T				
ART UNIT		PAPER NUMBER		
3695				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/916,927

Applicant(s)

DURAN, RUBEN G.

Examiner

HARISH T. DASS

Art Unit

3695

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to applicant's communication of 7/20/2009.

Priority: 7/27/2001

Status of claims:

Claims 1-22 are pending (claim 22 is new).

Claim 23 is restricted.

Election/Restrictions

1. Newly submitted claim 23 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 23 has a different scope than claims 1-22.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 23 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 22 is rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such

as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example **by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.**

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine.

The mere recitation of the machine with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. Insignificant extra-solution activity will not transform an unpatentable principle into a patentable process (see John Love, Deputy Commissioner for Patent Examination Policy, memorandum Jan. 7, 2009).

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyeret al-
http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=0

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Particularly,

Claims 1 line 2 (etc) "configured" is not supported by original specification.

In order to remove this rejection, for each instance, applicant should provide support for "configured" or equivalent words or passages.

Claim 1 "first software" and "second software".

Claim 1, "first communication device" and "second communication device"

In order to remove this rejection, for each instance, applicant should provide support (page number and lines) in original specification.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 22 recite the limitation " the second

party " in claim 1 line 24 (last line) and in claim 22 line 8 (last line). There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Triola (US 2001/0047328 A1).

Re. Claim 1, Triola discloses

a server configured to facilitate an escrow transaction between [see entire document which relates to escrow, particularly - Abstract; Figures 1, 3; paragraphs 9 (Client-Server), 43-53, 55 (client module/server module)]:

a first escrow client subsystem (client) disposed in a first location, said first escrow client subsystem including [paragraphs 36, 55, 92]:

first software configured to facilitate the escrow arrangement [Figure 3; paragraphs 17-20 (background), 34],

a first communication device operable to communicate escrow information based on instructions from said first software (client program) [paragraphs 44, 57], and

a first display [Figures 1a(#103,202,210, 306, 307), 1b(#212, 308,203,104), 1c(#312, 313, 317), Figure 3; paragraphs 9, 98]; and

a second escrow client subsystem (client) disposed in a second location, said second

escrow client subsystem including [supra, also see In re Harza]:

second software configured to facilitate the escrow arrangement [supra],
a second communication device operable to communicate escrow information based on instructions from said second software [supra], and

a second display [supra];

wherein the server interfaces with a network thereby connecting said first and second

client subsystems [paragraphs 9, 67, 88-98], and

wherein the escrow transaction comprises a conditional delivery of items from a first party to a third party until certain conditions are satisfied followed by delivery of the items from the third party to the second party [paragraph 17 (buyer, seller, principals, escrow officer)].

Claims 2-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Triola as applied to claims 22, and claim 1 above, and further in view of Mini et al. (hereinafter Mini – US 6,684,196).

Re. Claims 2-22, Triola discloses providing an escrow service between a first escrow service provider at a first location and a secondary escrow service provider operating at a second location [supra] and wherein the escrow service at least partially comprises a conditional delivery of items from a first party to a third party until certain conditions are satisfied followed by delivery of the items from the third party to the second party [supra].

Mini in the same field of endeavor discloses employing a videoconferencing system between the first location and the second location for purposes of facilitating providing the escrow service [Abstract; Figure 9, col. 2 lines 60-67; col. 8 lines 40-55 (video conference includes camera)].

2. Mini discloses wherein said software includes code for receiving customer escrow data [col. 14 lines 19-23; col. 18 lines 5-17; col. 20 lines 1-17].

3. Mini discloses wherein said software includes code for displaying a list of escrow companies [col. 6 lines 41-48; col. 10 lines 3-47].

4. Mini discloses wherein said list is customized based on said user data [col. 2 lines 49-59 – see personalized].

5. Mini discloses wherein said list is customized based on said broker data [col. 2 lines 49-59 – see personalized].

6. Mini discloses software includes code for establishing a video-conference between said first client and said second client via said network [col. 1 lines 51-56 (meet and communicate); col. 2 lines 61-63; col. 8 lines 48-55].

7. Mini discloses wherein said software includes code for facilitating an escrow opening meeting online [col. 1 lines 51-56 (meet and communicate); col. 2 lines 61-63; col. 8 lines 48-55].

8. Mini discloses software includes code for running customized applications [col. 2 lines 49-59 – see personalized].

9. Mini discloses wherein said applications are customized based on the parameters provided by an escrow agent, a customer, and or a third party [col. 14 lines 19-23; col. 18 lines 5-17; col. 20 lines 1-17].

10. Mini discloses wherein said third party is a real estate broker [col. 1 lines 28-40 – see realtor].

11. Mini discloses wherein said software includes code for retrieving an existing escrow account [col. 2 lines 63-65; col. 18 lines 17-18 – account =data as for computer is concern].

12. Mini discloses wherein said display is a flat-panel display [Figures 26-27 # 2604; col. 19 line 22, line 51 – see video display which can be flat panel display].

13. Mini discloses wherein said network is the Internet [col. 16 lines 43-455].

14. Mini discloses wherein said network is a private network [col. 16 lines 43-455 – see LAN].

15. Mini discloses wherein said first office is an escrow office [col. 1 lines 28-41; lines 51-56].

16. Mini discloses wherein said escrow office is an independent escrow office [col. 1 lines 28-41; lines 51-56; col. 5 line 34 – independent agent].

17. Mini discloses including plural first client subsystems disposed in plural respective independent escrow offices [col. 4 lines 7-16; col. 16 lines 12-35, line 64-66 – see distributed system].

18. Mini discloses wherein said second office is a broker's office [col. 1 lines 28-41; lines 51-56; col. 5 line 34].

19. Mini discloses including plural second client subsystems disposed in plural respective brokers offices [col. 4 lines 7-16; col. 16 lines 12-35, line 64-66 – see distributed system].

20. Mini discloses 20. The invention of claim 16 wherein said second office is a title insurance office [col. 1 lines 28-41; lines 51-56; col. 5 line 34; col. 2 lines 53-55 – title company].

21. Mini discloses input/output devices [col. 19 lines 48-65] and video conference (wherein said communication device is a camera) [col. 8 line 52 - video conference includes camera].

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosure Triola and Mini to facilitate a transaction between a buyer and seller through trusted third party over the network and online audio and video conferencing means to allow the two parties to know each other

over the virtual network and negotiation the terms, condition and delivery of valuables through a trusted party.

Response to Arguments

8. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HARISH T. DASS whose telephone number is (571)272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kyle Charles can be reached on 571-272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harish T Dass/
Primary Examiner, Art Unit 3695

Wednesday, March 24, 2010